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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Re Application of:

Joy, et al.

Serial No.: 10/721,476

Group Art Unit: 3764

Examiner: To be assigned

Filed: November 25, 2003

For: Systems and Methods for Respiration Measurement

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

ATTENTION: Director of Office of Initial Patent Examination (M.P.E.P. §1002.02(q))

**PETITION FOR CORRECTION OF INVENTORSHIP OF PATENT APPLICATION
(37 C.F.R. § 1.48(d) and (e))**

NOTE: See § 201.03 of the M.P.E.P. (6th ed., rv. 3)

1. This is a petition for correction of error in a

(check the appropriate item below)

- ☐ misjoinder
☒ nonjoinder

of inventor(s) in the above issued patent. It is respectfully requested that the PTO correct the error in inventorship.

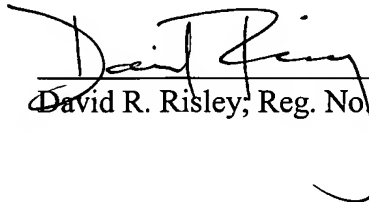
2. Enclosed herewith is (37 C.F.R. §1.48(d)(1) and 1.48 (e)(1),(2)):

- ☒ a statement from a registered attorney of record to correct the inventorship and that identifies the inventor being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor; and
☒ a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive invention on his or her part.

4. The fee required (37 C.F.R. §1.17(i)) is paid as follows:

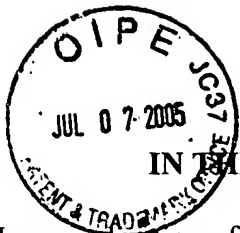
- ☒ Enclosed a credit card authorization form in the amount of \$130.00
☐ Charge Deposit Account 20-0778 \$130.00.

Respectfully submitted,



David R. Risley, Reg. No. 39,345

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Joy, et al.
Application Serial No.: 10/721,476
Filed: November 25, 2003
For: Systems and Methods for Respiration Measurement
Patent No.: TBA
Issue Date: TBA

Mail Stop
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

**CERTIFICATE UNDER 37 C.F.R. §3.73(b)
ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION**

1. The assignee of the entire right, title and interest hereby seeks to take action in the PTO in this matter.

IDENTIFICATION OF ASSIGNEE

2. The assignee of this matter is:

**SECTOR MEDICAL CORPORATION
320 NORTHPOINT PARKWAY, SUITE P
ACWORTH, GA 30102**

PERSON AUTHORIZED TO SIGN

3. David R. Risley
Attorney for Assignee

4. A chain of title from the inventor(s) to the current assignee is shown below:

- a. From: James A. Joy
To: Sector Medical Corporation
Recorded in PTO: Reel: 011584 Frame: 0764
- b. From: Wilton J. Pyle, III
To: Sector Medical Corporation
Recorded in PTO: Reel: 0115584 Frame: 0764

DECLARATIONS

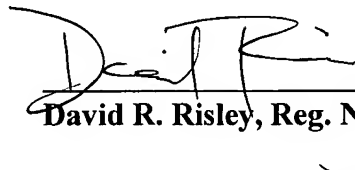
5. I, the undersigned, have reviewed all the documents in the chain of title of the

☒ application
☐ patent

matter identified above and, to the best of my knowledge and belief, title is in the assignee identified above.

6. I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

7. I, the person signing below, aver that I am empowered to sign this statement on behalf of the assignee.



David R. Risley, Reg. No. 39,345

Tel. No. 770-933-9500
Customer No.: 24504

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**
100 Galleria Parkway, Suite 1750
Atlanta, Georgia 30339-5948

Docket No. 221901-1010



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Joy, et al.

Serial No.: 10/721,476

Filed: November 25, 2003

For: Systems and Methods for Respiration)
Measurement)

)
)
) Group Art Unit: 3764

) Examiner: To be assigned

) Docket No.: 221901-1010

REQUEST FOR CORRECTION OF INVENTORSHIP

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In regard to the above-noted application, applicant submits the following Request for Correction of Inventorship.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account No. 20-0778.

CERTIFIED MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as "First Class Mail," in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Alexandria, Virginia 22313-1450 on

July 5, 2005
Signature: Mary Meegan

I. Statement of Request

Pursuant to 37 C.F.R. § 1.48(a), applicant hereby requests correction of the inventorship of the above-noted patent application (Serial No. 10/721,476). At present, the application names James A. Joy and Wilton J. Pyle, III as joint inventors of the claimed subject matter. In that Bradley Jeffries (hereinafter “Mr. Jeffries”) also contributed to the conception of the claimed subject matter, this Request seeks to add Mr. Jeffries as a named inventor in the application.

As is discussed below, the original inventorship error occurred without deceptive intention. Included with this Request is an affidavit from the unintentionally excluded inventor, a newly executed Declaration for Patent Application, the fee required by 37 C.F.R. § 1.17(i), and the written consent of the assignee.

II. Statement of Facts

1. The patent application presently names two inventors, James A. Joy and Wilton J. Pyle, III.

2. Despite not being identified as named inventors upon the filing of the patent application, Mr. Jeffries contributed to the conception of the subject matter of the patent application.

3. Mr. Jeffries avers that the error occurred without any deceptive intention on his part.

III. Statement of the Reasons Why Relief Should Be Granted

The correction of inventorship for U.S. Patent Applications is governed by 37 C.F.R. § 1.48. Under § 1.48, correction of inventorship is permissible if the present designation of inventorship is incorrect due to an error that arose without any deceptive intention on the part of the inventor or inventors that, through error, were not named as inventors. 37 C.F.R. § 1.48(a). Each of these requirements is satisfied in the instant case, as is discussed below.

A. The Original Designation of Inventorship is Incorrect

As is stated above, the first element to establish before inventorship may be amended is that the original designation of inventorship is incorrect. The case law makes clear that conception is the key to determining inventorship. See Sewall v. Walters, 21 F.3d 411, 415, 30 U.S.P.Q.2d 1356, 1358 (Fed. Cir. 1994)(“Determining ‘inventorship’ is nothing more than determining who conceived the subject matter at issue”); Fina Oil & Chem. Co. v. Ewen, 123 F.3d 1466, 43 USPQ2d 1935 (Fed. Cir. 1997)(“Conception is the touchstone to determining inventorship”). As has been expressed by the Court of Appeals for the Federal Circuit, although there is no explicit lower limit on the quantum or quality of the inventive contribution for qualification as a joint inventor, a joint inventor “must contribute in some significant manner to the conception of the invention.” Fina Oil, at 1473, 1941 (citations omitted). Furthermore, a person is not a co-inventor if his or her contribution merely equates to an explanation to the actual inventor concepts that are well known in the art. Id.

In the instant case, Mr. Jeffries contributed to the conception of the claimed invention as evidenced by his declaration.

B. The Original Designation of Inventorship Was Made Without Deceptive Intention

Under Rule 48, the original incorrect designation of inventorship must have occurred due to “error” that arose without “deceptive intention” on the part of the omitted inventor(s). 37 C.F.R. § 1.48(a). It has been long established that the meaning of the term “error” includes not only errors in recordation and transcription, but also errors of judgment, *i.e.*, mistakes. In re Schmidt, 293 F.2d 274, 278, 130 USPQ 404, 408 (C.C.P.A. 1961)(35 U.S.C. § 116 permits correction for *bona fide* mistakes in joining a person as an inventor). Indeed, with the liberalization of the requirements pertaining to correction of inventorship that has taken place over the latter half of this century, “error” has been construed to include even “gross” misunderstandings of patent law on the part of the inventor's patent attorneys, as long as each misunderstanding was innocent. See Azoplate Corp. v. Silverlith, Inc., 367 F. Supp. 711, 729, 180 USPQ 616, 629 (D.C. Del. 1973)(innocent mistakes as to the law made by the inventor's patent attorney qualify as errors under 35 U.S.C. § 116).

Mr. Jeffries was not included as a named inventor due to misunderstanding as to his actual contribution to the claimed inventions. In any case, Mr. Jeffries has averred that this omission occurred without deceptive intention.

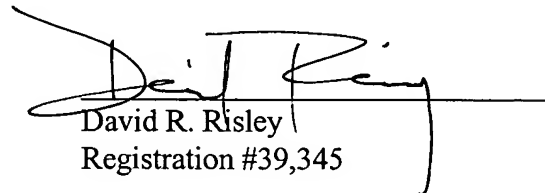
C. The Procedural Formalities of Rule 48 Have Been Satisfied

Included with the present Request is a statement from each person being added as an inventor that the error occurred without deceptive intention on his or her part, a newly executed declaration, the processing fee set forth in 37 C.F.R. § 1.17(i), and the written consent of the assignee. Accordingly, each of the requirements of 37 C.F.R. § 1.48(a) has been met.

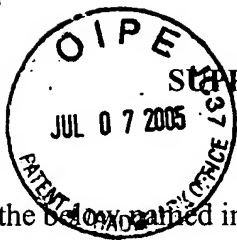
IV. Conclusion.

The instant Request for Correction of Inventorship, and its accompanying exhibits, satisfy the requirements of 37 C.F.R. § 1.48(a). Thus, applicant respectfully requests that Mr. Jeffries be added as inventor to the instant application.

Respectfully submitted,


David R. Risley
Registration #39,345

Date: 7/5/05



SUPPLEMENTAL DECLARATION FOR PATENT APPLICATION

Attorney Docket No: **221901-1010**

As the below named inventor(s), I/we hereby declare that:

Our residences, post office addresses and citizenships are as stated below next to our names.

We believe we are the original, first, and joint inventors of the subject matter which is claimed and for which a patent is sought on the invention entitled **Systems and Methods for Respiration Measurement**, the specification of which:

- ☐ is attached hereto.
☒ was filed on **November 25, 2003** as Application Serial No. **10/721,476**.
☐ was filed on _____ under U.S. Express Mail No. _____.
☐ is set forth in PCT International Application No. _____;
filed on _____ and as amended Under PCT Article 19 on _____ (if any).

I/we hereby state that I/we have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I/we acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I/we hereby claim foreign priority benefits under Title 35, United States Code, 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America listed below and have also identified below any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed: **NOT APPLICABLE**.

I/we hereby appoint all attorneys and agents of Thomas, Kayden, Horstemeyer & Risley, LLP, who are listed under the USPTO Customer Number shown below as my/our attorneys and agents to prosecute this application and to transact all business in the United States Patent and Trademark Office connected therewith, recognizing that the specific attorneys and agents listed under that Customer Number may be changed from time to time at the sole discretion of Thomas, Kayden, Horstemeyer & Risley, LLP, and request that all correspondence be addressed to the address filed under the same USPTO Customer Number.

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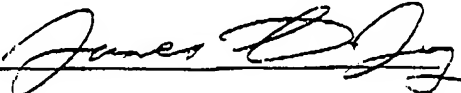
Please address all telephone calls, in the first instance, to **David R. Risley** at telephone number: (770) 933-9500.

Address all correspondence to:

David R. Risley
THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.
100 Galleria Parkway, N.W., Suite 1750
Atlanta, Georgia 30339-5948

I/we hereby declare that all statements made herein of my/our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statement and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of First Inventor: James A. Joy
Residence: 140 Pebble Trail, Alpharetta, GA 30004 Citizenship: US
Post Office Address: same as above

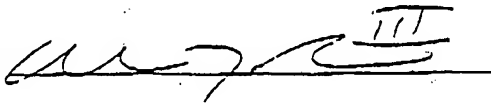
Inventor's Signature:  Date: July 19, 2004

Full Name of Second Inventor: Wilton J. Pyle, III

Residence: 3591 Downing Street, NE, Marietta, GA 30066

Citizenship: US

Post Office Address: same as above

Inventor's Signature: 

Date: July 19, 2004

Full Name of Third Inventor: Bradley Jeffries

Residence: 4998 Lost Valley Lane, Powder Springs, GA 30127 Citizenship: US

Post Office Address: same as above

Inventor's Signature: _____

Bradley Jeffries

Date: _____

6/24/2005